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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,571	09/11/2001	Kenneth R. Chien	ST-UCSD3210	7236

7590 09/07/2007

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EXAMINER	
KAUSHAL, SUMESH	
ART UNIT	**PAPER NUMBER**
1633	

MAIL DATE	DELIVERY MODE
09/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/954,571	CHIEN ET AL.	
	Examiner	Art Unit	
	Sumesh Kaushal	1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *21 June 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *70-72,77,78,86-91,93 and 97* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *70-72, 77-78, 86-91, 93 and 97* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's response filed on 06/21/07 has been acknowledged.

Claims 70-72, 77-78, 86-91, 93 and 97 are pending and are examined in this office action.

Applicants are required to follow Amendment Practice under revised 37 CFR §1.121. The fax phone numbers for the organization where this application or proceeding is assigned is ***571-273-8300.***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The references cited herein are of record in a prior Office action.

Claim Rejections - 35 USC § 112

Claims *70-72, 77-78, 86-91, 93 and 97* are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for treating heart failure associated with loss of cardiac muscle contractility and method for reducing the reoccurrence of cardiac interstitial fibrosis by intra-coronary administering an adeno-associated viral vector (AAV) encoding transdominant negative phospholamban (S16E PLB), does not reasonably provide enablement for a method of treating heart failure associated with loss of cardiac muscle contractility and reduce the reoccurrence of cardiac interstitial fibrosis, wherein the S16E PLB gene is administered via any and all means to any and all target sites. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims, for the same reasons of record as set forth in the office action mailed on 03/13/07.

Response to Argument (enablement)

The applicant argues that applicants have amended the claims to recite use of the S16E mutant to treat heart failure associated with loss of cardiac muscle contractility by increasing SERCA2 mediated contractility. Applicants submit that the amended

claims are in line with the scope of enablement identified in the Office Action, and are therefore in condition for allowance.

However the applicant's arguments are found not persuasive. The scope of invention as claimed encompasses a method of treating heart failure associated with loss of cardiac muscle contractility and reduce the reoccurrence of cardiac interstitial fibrosis, wherein the S16E PLB gene is delivered to the heart via any and all means. For example the scope of invention as claimed encompasses the administration of the S16E PLB gene via any and all routes of administration (systemic, topical, intra-dermal, oral, nasal and direct injection etc) using any viral or non-viral vector.

The earlier office action provided clear evidence that it has been difficult to predict the efficiency and out come of transduced therapeutic genes because various factors govern the expression and/or therapeutic potential of transduced genes in vivo. The transduction of target cells represents the first critical step in gene therapy, which not only depends upon the type of target cells but also on the choice and/or characteristics of delivery vectors. Furthermore, in-vitro gene transfer studies are not predictive of in vivo gene therapy because gene transfer frequency is much higher in-vitro models where most of cells are under going rapid cell division, which is quite not the case in-vivo environment. In addition, besides the limitations in gene transfer the problem to selectively target cells in vivo is still one of the most difficult obstacles to overcome. The viral particles binds to many cells they encounter in vivo and therefor would be diluted out before reaching their targets. In addition there exists an uncertainty about the degree to which a vector's genetic material may integrate into the host genome extends to most types of gene therapy trials. At best the specification as filed discloses intra-coronary administration of adeno-associated vector (AAV-S16EPLB) that leads to gene delivery to heart muscles.

Furthermore, treating a heart failure as claimed wherein the S16E PLB gene is delivered via any and all means and to any target site is not considered routine in the art and without sufficient guidance to a specific target site and method of specific vector delivery the experimentation left to those skilled in the art is unnecessarily, and improperly, extensive and undue. see in re wands 858 f.2d 731, 8 uspq2nd 1400 (fed.

cir, 1988). It is noted that the unpredictability of a particular area may alone provide reasonable doubt as to the accuracy of the broad statement made in support of enablement of claims. see ex parte Singh, 17 uspq2d 1714 (BPAI 1991). Therefore considering the state of the art and limited amount of guidance provided in the instant specification, one skill in the art would have to engage in excessive and undue amount of experimentation to exercise the invention as claimed.

Terminal Disclaimer

The terminal disclaimer filed on 06/2/07 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of 10/705,791 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal whose telephone number is 571-272-0769. The examiner can normally be reached on Mon-Fri. from 9AM-5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SUMESH KAUSHAL
PRIMARY EXAMINER